

### **REMARKS**

The Applicants' note with appreciation the Examiner's identification of allowable subject matter recited in Claims 4-24. Applicant's further thank the Examiner for the opportunity to discuss the pending claims, as identified below, in a telephone interview. The following amendment amends Claims 13 and 25 to clarify the subject matter in each claim. Specifically, Claim 25 is amended to address the rejections under 35 U.S.C. §112. The amendment to Claim 13 is meant to clarify the recited subject matter and is not meant to address any art rejection. No new matter is added and no new issues are raised. Thus, consideration of the proposed amendments requires no further search.

Now in the application are Claims 1-28 and 31-40, of which Claims 1, 8, and 25, are independent. The following comments address all stated grounds for rejection and place the presently pending claims, as identified above, in condition for allowance.

### **Claim Rejections under 35 U.S.C. § 112**

#### **A. Rejection of Claims 25-28 and 31-40 under 35 U.S.C. § 112, first paragraph:**

Claims 25-28 and 31-40 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Specifically, the Examiner contends that in Claim 25 and dependent claims therefrom, the limitation "each said first and second cell group including at least one cell and having a heat load distinct from the other cells" does not appear in the original disclosure. In particular, the Examiner contends it is unclear what "other cells" are being referred to.

Applicants' respectfully direct the Examiner's attention to page 13, lines 1-34 of the specification for a discussion of the subject matter recited Claim 25. Further, Applicant's amend Claim 25 to remove the recitation of "and having a heat load distinct from the other cells", thereby clarifying the recited subject matter.

Accordingly, Applicants' respectfully request the Examiner to reconsider and withdraw the rejection of Claims 25-28 and 31-40 under 35 U.S.C. § 112, first paragraph.

**B. Rejection of Claims 25-28 and 31-40 under 35 U.S.C. § 112, second paragraph:**

Claims 25-28 and 31-40 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants' regard as their invention. Specifically, the Examiner contends that the limitation "each said first and second cell group including at least one cell and having a heat load distinct from the other cells" is indefinite because it is unclear what other cells are being referred to. Applicants' amend Claim 25 to remove "and having a heat load distinct from the other cells", thereby clarifying the recited subject matter.

With this amendment to Claim 25 Applicants' contend that Claims 25-28 and 31-40 are definite for the recited features particularly point out and distinctly claim the subject matter Applicants' regard as their invention. Accordingly, Applicants' respectfully request the Examiner to reconsider and withdraw the rejection of Claims 25-28 and 31-40 under 35 U.S.C. § 112, second paragraph.

**Claim Rejections under 35 U.S.C. § 102**

**A. Rejection of Claims 1 and 2 under 35 U.S.C. § 102(e):**

The Office Action rejects Claims 1 and 2 as being anticipated by U.S. Patent No. 6,537,694 of Sugiura, *et al.* (hereinafter "Sugiura"). Applicants' respectfully traverse this rejection in light of the enclosed Declaration pursuant to 37 C.F.R. § 1.132 to establish the patentability of Claims 1 and 2 now pending in this application.

Applicants' contend that the Sugiura reference includes a common inventor Kazuyuki Sakakibara and assignee, Makita Corporation with the instant application and that the subject matter disclosed but not claimed in the Sugiura reference was derived from the common inventor identified in the instant application. Applicants' assert that Kazuyuki Sakakibara conceived or invented the subject matter disclosed in the Sugiura reference and relied upon by the Examiner to reject Claims 1 and 2 of the instant application. Accordingly, Applicants' contend that the submitted Declaration pursuant to 37 C.F.R. § 1.132 overcomes the rejection of Claims 1 and 2

as being anticipated by the Sugiura reference by establishing fact that the subject matter relied on in the Sugiura reference was the invention of one of the Applicants' in the instant application.

In the Response to the Office Action mailed July 9, 2003, Applicants mistakenly submitted a defective declaration under 37 C.F.R. §1.132. Specifically, the cover page of that declaration identified the common inventor as Mr. Youichi Kato, however, Mr. Kazuyuki Sakakibara executed the declaration. Applicants respectfully contend this collation error was unintentional and not meant to mislead the Examiner in any way.

Specifically, in response to the Office Action mailed July 9, 2003, the Applicants after reviewing the Sugiura patent determined that a declaration under 37 C.F.R. §1.132 could be factually supported to overcome the cited Sugiura patent. However, Applicants did not identify to the attorney listed below which common inventor, Youichi Kato or Kazuyuki Sakakibara, from the instant application and the cited Sugiura patent was the inventor of the disclosed, but unclaimed subject matter in the Sugiura patent relied upon by the Examiner to reject Claims 1 and 2. As such, this attorney drafted two declarations for the Applicants; one for Mr. Kato and one for Mr. Sakakibara. Applicants returned to their representative an executed declaration under 37 C.F.R. §1.132 from Mr. Sakakibara.

On November 7, 2003, the day of filing a Response to the Office Action mailed July 9, 2003, the assistant of the below identified attorney, mistakenly entered the Express Mail No. and date in the Express Mail Certificate on the cover page of the declaration corresponding to Mr. Kato. The cover page of the Mr. Kato's declaration was printed, collated with the signature page of the declaration corresponding to Mr. Sakakibara, and presented to the below identified attorney for execution of the Certificate of Express Mail. In turn, and without recognizing the collation error, the below identified attorney executed Certificate of Express Mail. Hence, the submission of the defective declaration under 37 C.F.R. §1.132 was the result of a ministerial error.


Accordingly, Applicants' respectfully request the Examiner to reconsider and withdraw the rejection of Claims 1 and 2 under 35 U.S.C. §102(e).

**CONCLUSION**

In view of the amendments and remarks set forth above, Applicants contend that Claims 1-28 and 31-40 are presently pending in this application, are patentable, and in condition for allowance. If the Examiner deems there are any remaining issues, we invite the Examiner to call the undersigned at (617) 227-7400.

Respectfully submitted,

LAHIVE & COCKFIELD, LLP

A handwritten signature in dark ink, reading "David R. Burns". The signature is written in a cursive style with a horizontal line underneath the name.

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Date: March 26, 2004



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re the application of:** Sakakibara, *et al.*

**Serial No.:** 09/707,723

**Filed:** November 7, 2000

**For:** *Battery Pack with an Improved Cooling Structure*

**Attorney Docket No.:** CTW-006

**Group Art Unit:** 1745

**Examiner:** S. Foster

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

"Express Mail" Mailing Label Number EV377651955US

Date of Deposit March 26, 2004

I hereby certify that this transmittal letter and the papers referred to as being enclosed therein are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*David R Burns*

Signature David R. Burns

Please Print Name of Person Signing

**DECLARATION UNDER 37 C.F.R. § 1.132**

Sir:

I, Kazuyuki Sakakibara, a citizen of Japan, residing at Apt. #901, 56-1 Azukisaka, Miai-cho, Okazaki-shi, Aichi-ken, Japan, hereby declare as follows:

(1) I am a co-inventor, along with Youichi Kato and Hisakazu Okabayashi, of the subject matter described and claimed in the above-identified application, assigned to Makita Corporation, Aichi-ken, Japan.

(2) I am also a co-inventor with Masatoshi Sugiura and Youichi Kato of the subject matter described and claimed in U.S. Patent No. 6,537,694 of Sugiura *et al.*, assigned to Makita Corporation, Aichi-ken, Japan, hereinafter, "Sugiura *et al.*".

USSN: 09/707,256  
Atty Dkt: CTW-006

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Group Art Unit: 1745

(3) I am the sole inventor of the subject matter described, but not claimed by Sugiura *et al.*, and relied upon by the Examiner to reject the above-identified application. Specifically, I am the sole inventor of a radiator having a heat capacity that increases in the downstream direction of a flow of cooling air. The radiator is provided in at least one air passage formed within a case of a battery pack. The air passage is formed within the case for allowing cooling air outside the case to enter the case and to pass at least one of along and between the cells, and exit from the case. The radiator is provided in the air passage so as to be in contact with an outer surface of cells contained in the case of the battery pack. Such a radiator is described, but not claimed by Sugiura *et al.*, at Column 6, lines 61 to 63.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

October 29, 2003  
Date

Kazuyuki Sakakibara  
Kazuyuki Sakakibara